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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/669,056	06/24/96	NACHMAN	B

MARVIN NACHMAN
315 SAYBROOK RD
VILLANOVA PA 19085

LM31/0720

EXAMINER

LEE, P. PAPER NUMBER

2722

DATE MAILED: 07/20/99

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 3-22-99
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three (3) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-53 is/are pending in the application.
- Of the above, claim(s) 1-26 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 27-53 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

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1. Applicant has elected Invention II claims 27-50 with traverse. Newly submitted claims 51-53 claiming a method using a facsimile machine with a computer, which fall in the invention II claim group, are grouped with Invention II claims. Claims 27-53 are now elected claims. Non-elected claims 1-26 are withdrawn from consideration.

2. The restriction is made final in this Office action because the invention II is directed to a method of using a facsimile machine(s) with a computer or a method of making the facsimile machine operatable as a scanner or a printer for a personal computer, which ^{is} different from the invention I claims that do not claim such method of use or making. The two inventions I and II require different search areas at least in part.

3. Claims 27-53 are rejected under **35 U.S.C. 112, second paragraph**, as failing to set forth the subject matter which applicant(s) regard as their invention.

In claim 27, line 1, the term "and/or" is indefinite because it is unclear whether both limitations "facsimile machines" and "facsimile modems internal to an office product" are the intended claim limitation or either one of the limitations is the intended limitation;

line 2, should "component" read -- computer -- ?

lines 2-3, it is unclear what the phrase "with data transferred in a conventional way" means because it is unclear between what devices or machines are the data transferred;

lines 3 and 4, the term "the original signals" lacks antecedent basis;

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line 4, "said devices" lacks antecedent basis;

lines 4-5, "said devices being directly connected and isolated from a connection with a telephone line" is confusing because it is not understood how the devices can be directly connected and also isolated from a connection with a telephone line;

The claim language of claim 27 is awkward.

In claim 28, line 1, "and/or" is indefinite because it is unclear whether the "and" or the "or" is the intended limitation since the use of "and" means that all of facsimile machines, facsimile modems internal or external to computers and various office products are involved, while the use of "or" means that either the facsimile machines or the facsimile modems internal to computers and various office products, but not both;

lines 2-3, the phrase "and being connected by telephone types of circuits" is unclear because it is unclear exactly what are being connected;

line 4, the term "the original signals" lacks antecedent basis;

lines 4-5, it is unclear whether the term "the telephone circuits" is the same as "telephone types of circuits" since different terminologies are used;

line 4, "connection" is unclear as in what are being connected;

part b), the phrase "such as ..." is indefinite because it is unclear whether the limitations following "such as" are intended limitation which is or are narrower than the limitation "internal initiation". The language "such as" is not definite claim language and should not be used in the claim; further, "for example" is not definite language because it is unclear whether the

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limitation, "PC mode" in this case, is the intended claim limitation; furthermore, "PC" should be spelled output;

part c), it is unclear what "any combination thereof" is referring to because when part c) is listed after part a) and part b) as it is in the claim, there should only be one combination which is the combination of part a) and part b). The word "any" suggests that there are more than one combination, which is not supported by the claim.

In claim 29, line 1, the term "The direct transfer" lacks antecedent basis;

line 3, it is unclear whether "isolated" means that the facsimile machine is isolated from the telephone line or the signals being transferred are isolated from the telephone line.

In claim 30, the term "The direct transfer" lacks antecedent basis.

In claim 31, line 1, the term "The direct transfer" lacks antecedent basis.

line 3, it is unclear what is being isolated from a telephone line. Is it the facsimile machine or the signals ?

In claim 32, "the method of claim 27" lacks antecedent basis. Claim 27 does not claim a method. Is "a fax machine" referring "a facsimile machine" of claim 27 ? If yes, the same terminologies should be used.

In claim 33, "the method of claim 27" lacks antecedent basis; is "a facsimile machine" and "a computer" referring to "a facsimile machine" and "a component" [computer] of claim 27 ? If yes, the same terminologies should be used.

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In claim 34, "the method of claim 27" lacks antecedent basis; is "a facsimile machine" and "a computer" referring to "a facsimile machine" and "a component" [computer] of claim 27 ? If yes, the same terminologies should be used.

In claim 35, "The direct transfer" lacks antecedent basis; it is unclear what the term "containing data" is modifying; is it modifying "direct transfer" or the "signals". Further, the claim language is confusing.

In claim 36, line 3, a comma -- , -- should be inserted before "comprising" in order to avoid confusion of the sentence structure;

line 5, "and isolated" does not flow from the phrase upstream thereof; it is unclear as in what is being isolated from the telephone line;

Claims 37-40 and 42 are rejected as being dependent upon claim 36.

Further in claim 40, "any combination of connectors" is indefinite; it is believed that the disclosure does not disclose just any combination of connectors to interface the fax machine and the personal computer. Furthermore, are "a fax machine" and "a computer" referring to "a facsimile machine" and "a computer" of claim 36 ? If yes, -- the -- or -- said -- should be used instead of "a".

In claim 41, "The method of claim 27" lacks antecedent basis. Claim 27 does not recite a "method".

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In claim 43, part a), "and isolated from..." is indefinite because it is unclear as in what is being isolated from the active telephone network. The language of part a) does not flow grammatically.

Claims 44-48 are rejected as being dependent upon a rejected base claim.

Further in claim 47, the language "using analog data transmissions, or digital serial, or parallel signal subsets thereof" does not flow grammatically.

In claim 49, it is not clear whether "isolated" means that the facsimile machine is isolated or the computer is isolated or both the facsimile machine and computer are isolated; "the active line" and "the direct transfer" lack antecedent bases.

In claim 50, it is not clear whether "isolated" means that the facsimile machine is isolated or the computer is isolated or both the facsimile machine and computer are isolated; "the active line" and "the direct transfer" lack antecedent bases.

In claim 51, part a), "and isolated from ..." is indefinite because it is unclear as in what is being isolated from the active telephone network. The language of part a) does not flow grammatically. Further, "the active telephone network" of part a) lacks antecedent basis.

In claim 52, "the telephone network" lacks antecedent basis.

In claim 53, "the telephone network" lacks antecedent basis.

4. Claims 27-31, 35-37, 43, 44, 47, and 49-53 are rejected under **35 U.S.C. 102(e)** as being anticipated by Perkins (U.S. Patent No. 5,452,106).

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Regarding claim 27, Perkins discloses a system and a method of a computer using a facsimile machine as a scanner or a printer. When used as a scanner, the facsimile machine (1) communicates scanned image data to the computer (2) through facsimile device (3). When used as a printer, the computer (2) communicates data to the facsimile machine (1) through the device (3). The computer (2) along with a fax board, or the combination of computer (2) and facsimile device (3), is conditioned to receive scanned document image or to transmit image signals to be printed and thus reads on the claim limitations. Because the computer uses a fax board, the data transferred to and from the computer is considered being transferred without manipulation or modification of the scanned document image signal.

Regarding claim 28, see discussion for claim 27. Although Perkins shows a telephone network, the network is not used for data transfer between the facsimile apparatus and the computer. The claim recites that the transmission includes one of a), b), and c) claimed. In part b), the internal initiation being the "PC mode" is met by Perkins' PC-fax mode (col. 7, line 5).

Regarding claim 29, see discussion for claims 27 and 28. The connection between the facsimile machine (1) and the computer is considered passive; the connection is isolated from the telephone line (at 15). Port (5) is considered a receiving port of the computer (2).

Regarding claim 30, see Perkins discussed above. The port (5) is a serial port connector of the computer which inherently includes an RS 232.

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Regarding claim 31, see Perkins discussed above. the signals being transferred are representative of scanned images from a standard facsimile machine (1). The computer is an office product.

Regarding claim 35, Perkins discussed above teaches transferring document image to be printed from the computer and at the facsimile machine (1).

Regarding claim 36, in Perkins, the facsimile machine (1) is made operatable as a scanner or a printer for the computer (2). Each of facsimile machine (1) and computer (2) isolated from telephone line (at 15). Both facsimile machine and computer are placed in a simulated off-hook condition.

Regarding claim 37, the port (5) reads on the claimed connector port.

Regarding claim 43 and 51-53, see Perkins discussed above.

Regarding claim 44, the port (5) between the facsimile machine and the computer is a serial data port.

Regarding claim 47, the serial data being transferred is digital serial data.

Regarding claims 49 and 50, see Perkins discussed above.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheukfan Lee at telephone number (703) 305-4867.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at telephone number (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

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or faxed to:

(703) 306-5406 (for formal communications intended for entry)

(703) 308-5397 (for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two
2121 Crystal Drive
Arlington, VA
Sixth Floor (Receptionist)

C. L.

July 18, 1999

Chenfan Lee
Chenfan Lee